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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,673	11/29/2001	Mario Visca	108910-00046	9940

4372 7590 03/27/2003

ARENT FOX KINTNER PLOTKIN & KAHN  
1050 CONNECTICUT AVENUE, N.W.  
SUITE 400  
WASHINGTON, DC 20036

EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 09/995,673	Applicant(s) VISCA ET AL.	
	Examiner Cephia D. Toomer	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This Office action is in response to the amendment filed December 31, 2002 in which claims 1-10 were amended and claims 12-14 were added.

The Double Patenting rejection is withdrawn in view of the filing of the Terminal Disclaimer.

The rejection of the claims under 35 USC 112, second paragraph is withdrawn in view of the amendments to the claims.

#### ***Claim Rejections - 35 USC § 102***

1. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Strepparola et al (US 5,980,642).

Strepparola teaches a method for removal of water from surfaces by applying an additive composition and skimming the surface to remove the water (see abstract). The additive composition is used in an amount of 0.1% or lower (see col. 3, lines 29-31). Strepparola teaches that his composition comprises a perfluoropolyether having a molecular weight of 300-1500 and a nonionic additive. Strepparola teaches all of the limitations of the present claims (see col. 1, lines 29-67; col. 2, lines 1-67; col. 3, lines 14-44).

Accordingly, Strepparola teaching all the limitations of the claims anticipates the claims.

2. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Strepparola (US 6,096,240).

Strepparola teaches a method for removal of water from surfaces by applying an additive composition and skimming the surface to remove the water (see abstract). The additive composition is used in an amount of 0.1% or lower (see col. 3, lines 38-40). Strepparola teaches that his composition comprises a perfluoropolyether having a molecular weight of 300-1500 and a nonionic additive. Strepparola teaches all of the limitations of the present claims (see col. 1, lines 27-67; col. 2, lines 1-67; col. 3, lines 9-40).

Accordingly, Strepparola teaching all the limitations of the claims anticipates the claims.

### ***Response to Arguments***

3. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues that neither Strepparola reference satisfies the ratio ( $K'$ ) of being higher than 1.6.

The examiner respectfully disagrees. The Strepparola references teach perfluoropolyethers having a molecular weight between 300 and 1500 (Applicant is claiming 300-900) and the molecular weight of the fluoropolyether part T-OR<sub>f</sub> is between 500 and 1200 (Applicant is claiming 400-2000). Given these molecular weights ranges, it is clear that both Strepparola references teach compositions that satisfy the ratio  $K'$ .

Applicant argues that neither Strepparola reference teaches removing the water by skimming.

Strepparola '642 teaches at col. 1, line 33 that the method of his invention "comprises covering the surface with a composition having specific weight higher than that of the water, and subsequently removing water from the composition by skimming". Strepparola '240 teaches this at (col. 1, lines 34-38).

Applicant's data have been taken under consideration but are not deemed to constitute unexpected results. The showings are not commensurate in scope. The examples are limited to X being  $\text{CH}_2\text{O}$  and B as OH. Also, the non-ionic additives of the comparatives are different from those of the invention. It cannot be ascertained if unexpected results are obtained.


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

C. Toomer/mn  
March 26, 2003